Docket No.: 511582003500
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mary FARIS, et al.

Application No.: 09/809,638

Art Unit: 1643

Filed: March 14, 2001

Examiner: A. Harris

For: 125P5C8: A TISSUE SPECIFIC PROTEIN HIGHLY EXPRESSED IN VARIOUS CANCERS

DECLARATION BY INVENTORS
UNDER 37 C.F.R. § 1.131

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We, the undersigned, declare as follows:

1. We are co-inventors of claims 1, 14 and 23, currently pending in the above-referenced application. The claims relate to an isolated 125P5C8 protein comprising the sequence of SEQ ID NO: 2 or a polynucleotide sequence encoding the codons for SEQ ID NO: 2, which is exemplified by the nucleotide sequence of SEQ ID NO:1.

2. The Office rejected claims 1, 14 and 23 as allegedly being anticipated by WO 200270539 A2, which was filed March 5, 2002. This PCT application claims priority to U.S. Application No. 09/799,451, which was filed March 5, 2001, and is now U.S. Patent No. 6,783,989.

A copy of WO 200270539 was submitted in an Information Disclosure Statement provided in this application mailed on April 5, 2001. This document discloses sequence 1397 which is identical to SEQ ID NO: 2 of the present application.

3. We reduced the claimed invention to practice in the United States prior to the date U.S. Patent No. 6,783,989 was filed (March 5, 2001).

4. This reduction to practice is evidenced by a true and accurate copy of an email message sent to various members of the scientific staff by inventor Steve C. Mitchell on January 3, 2001. The email provides the nucleic acid and amino acid sequences of the material encompassed by the claims in the above-referenced patent application. A copy of this email is provided as Exhibit A.

5. The nucleotide sequence disclosed in Exhibit A consists of 2,103 nucleotides and 699 amino acids.

6. Exhibit B shows a comparison of the nucleotide sequence of SEQ ID NO:1 and the nucleotide sequence disclosed in Exhibit A. Every single nucleotide disclosed in SEQ ID NO:1 is present in the nucleotide sequence disclosed in Exhibit A. Accordingly, the email of Exhibit A clearly demonstrates the that nucleotide sequence of SEQ ID NO:1 was in our possession prior to the earliest priority date to which WO 200270539 (the cited art) is entitled to claim.

7. Exhibit C shows a comparison of the amino acid sequence of SEQ ID NO:2 and the amino acid sequence disclosed in Exhibit A. Every single amino acid residue disclosed in SEQ ID NO: 2 is present in the amino acid sequence disclosed in Exhibit A. Accordingly, the email of Exhibit A clearly demonstrates the that amino acid sequence of SEQ ID NO:2 was in our possession prior to the earliest priority date to which WO 200270539 (the cited art) is entitled to claim.

8. In view of the email provided as Exhibit A and the analysis of the sequences disclosed therein and shown in Exhibits B and C, we declare that the invention of the pending claims was reduced to practice in the United States prior to March 5, 2001, the earliest priority date available to the cited document.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date	Executed at	
01/26/2006	Santa Monica, CA (City/State)	Aya JAKOBOVITS
	(City/State)	Daniel E.H. AFAR
	(City/State)	Steve Chappell MITCHELL
1/27/06	Santa Monica, CA (City/State)	Pia M. CHALLITA-EID
1-27-06	Santa Monica CA (City/State)	Arthur B. RAITANO
	(City/State)	Mary FARIS

8. In view of the email provided as Exhibit A and the analysis of the sequences disclosed therein and shown in Exhibits B and C, we declare that the invention of the pending claims was reduced to practice in the United States prior to March 5, 2001, the earliest priority date available to the cited document.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date	Executed at	
	(City/State)	Aya JAKOBOVITS
2/1/2006	FREMONT, CA	Daniel E.H. AFAR
	(City/State)	
	(City/State)	Steve Chappell MITCHELL
	(City/State)	Pia M. CHALLITA-EID
	(City/State)	Arthur B. RAITANO
	(City/State)	Mary FARIS

Popp, Shane

From: Mitchell, Steve
Sent: Wednesday, January 03, 2001 1:43 PM
To: Scientists
Subject: 125P5C8 reagents.

Colleagues,

The Company reagent for 125P5C8 (124P1B7/139P3A1) is pasted. It is a PCR based pCR2.1/TA clone(prostate) with three point differences from the Japanese (colon) reported hypothetical sequence.
Two point are conserved for translation whereas the third point difference gives an amino acid change near the 3 prime end. This is verified with genomic sequencing.

>125P5C8(124P1B7/139P3A1) pCR2.1 subclone
CGATGACCTCGCTGTGGAGAGAAATCCTCTTGGAGTCGCTGCTGGGATGTGTTTCTTGGTCTCTCTACCATGACCTGGGACCGATG
ATCTATTACTTTCCTTTGCAAACACTAGAACTCACTGGGCTTGAAGGTTTTAGTATAGCATTTCTTTCTCCAATATTCCTAACAATTACT
CCTTTCTGGAAATTGGTTAACAAGAAGTGGATGCTAACCCTGCTGAGGATAATCACTATTGGCAGCATAGCCTCCTTCCAGGCTCCA
AATGCCAAACTTCGACTGATGGTTCTTGCGCTTGGGGTGTCTTCCTCACTGATAGTGCAAGCTGTGACTTGGTGGTCGGGAAGTCAT
TTGCAAAGGTACCTCAGAATTTGGGGATTCATTTTAGGACAGATTGTTCTTGTTGTTCTACGCATATGGTATACTTCACTAAACCCAAT
CTGGAGTTATCAGATGTCCAACAAAGTGATACTGACATTAAGTGCCATAGCCACACTTGATCGTATTGGCAGGGGCTGCTTTGGT
TAAACCTGAAGAAAAGAAGACTGGTGAGGTAGCCACGGGGATGGCCTCTAGACCCAACTGGCTGCTGGCAGGGGCTGCTTTGGT
AGCCTTGTGTTCCTCACCCACTGGGTTTTTGGAGAAGTCTCTCTTGTTTCCAGATGGGCAGTGAGTGGGCATCCACATCCAGGGCC
AGATCCTAACCCATTTGGAGGTGCAGTACTGCTGTGCTTGGCAAGTGGATTGATGCTTCCATCTTGTTTGTGGTTTCGTGGTACTGG
TTTGATCTGGTGGGTTACAGGAACAGCTTCAGCTGCGGGGCTCCTTTACCTGCACACATGGGCAGCTGCTGTGTCTGGCTGTGTCT
TCGCCATCTTTACTGCATCCATGTGGCCCCAAACACTTGGACACCTTATTAACTCAGGGACAAACCCTGGGAAAACCATGACCATTG
CCATGATATTTTATCTTCTAGAAATATTTTTCTGTGCCTGGTGCACAGCTTTTAAGTTTGTCCCAGGAGGTGTCTACGCTAGAGAAAG
ATCAGATGTGCTTTTGGGGACAATGATGTTAATTATCGGGCTGAATATGCTATTTGGTCCTAAGAAAAACCTTGACTTGCTTCTTCAA
ACAAAAAACAGTTCTAAAGTGCTTTTCAGAAAGAGTGAAAAATACATGAAACTTTTTCTGTGGCTGCTTGTTGGTGTGGGATTGTTGG
GATTAGGACTACGGCATAAAGCCTATGAGAGAAAACTGGGCAAAGTGGCACCAACCAAAGAGGTCTCTGCTGCCATCTGGCCTTTC
AGGTTTGGATATGACAATGAAGGGTGGTCTAGTCTAGAAAGATCAGCTCACCTGCTCAATGAAACAGGTGCAGATTTCATAACAATT
TTGGAGAGTGATGCTTCTAAGCCCTATATGGGGAACAATGACTTAACCATGTGGCTAGGGGAAAAGTTGGGTTTCTATACAGACTTT
GGTCCAAGCACAAGGTATCACACTTGGGGGATTATGGCTTTGTCAAGATACCCAATTGTGAAATCTGAGCATCACCTTCTTCCGTCA
CCAGAGGGCGAGATCGCACCAGCCATCACATTGACCGTTAACATTTCGGGCAAGCTGGTGGATTTTGTCGTGACACACTTTGGGAA
CCACGAAGATGACCTCGACAGGAAACTGCAGGCTATTGCTGTTTCAAAACTACTGAAAAGTAGCTCTAATCAAGTGATATTTCTGGG
ATATATCACTTCAGCACCTGGCTCCAGAGATTATCTACAGCTCACTGAACATGGCAATGTGAAGGATATCGACAGCACTGATCATGA
CAGATGGTGTGAATACATTATGTATCGAGGGCTGATCAGGTTGGGTTATGCAAGAATCTCCCATGCTGAACTGAGTGATTCAGAAAT
TCAGATGGCAAAATTTAGGATCCCTGATGACCCCACTAATTATAGAGACAACCAGAAAGTGGTCATAGACCACAGAGAAGTTTCTGA
GAAAATTCATTTTAATCCCAGATTTGGATCCTACAAAGAAGGACACAATTATGAAAACAACCATCATTTTCATATGAATACTCCCAAAT
ACTTTTTATGAAAC
>125P5C8(124P1B7/139P3A1) pCR2.1 subclone
MTSLWREILLESLLGCVSWSLYHDLGPMIYYFPLQTLELTGLEGFSIAFLSPIFLTITPFWKLVNKKWMLTLLRITIGSIASFQAPNAKLRLM
VLALGVSSSLIVQAVTWWSGSHLQRYLRIWGFILGQIVLVVLRIWYTSLNPIWSYQMSNKVILTLSAIATLDRIGTDGDCSKPEEKKTGEVA
TGMASRPNWLLAGAAFGSLVFLTHWVFGEVSLVSRWAVSGHPHPGPDPNPFGGAVLLCLASGLMLPSCLWFRGTGLIWWVTGTASAA
GLLYLHTWAAAVSGCVFAIFTASMWPQTLGHLINSGTNPGKTMTIAMIFYLLEIFFCAWCTAFKFVPGGVYARERSDVLLGTMMLIIGLNML
FGPKKNLDLLLQTKNSSKVLFRKSEKYMKLFLWLLVGVGLLGLGLRHKAYERKLGKVAPTKEVSAAIWPFRFGYDNEGWSSLERSAHLL
NETGADFITILESDASKPYMGNNDLTMWLGEKLGFYTDFGPSTRYHTWGIMALSRYPIVKSEHHLLPSPEGEIAPAITLTVNISGKLVDFVV
THFGNHEDDLDRKLQAIAVSKLLKSSSNQVIFLGYITSAPGSRDYLQLTEHGNVKDIDSTDHDRWCEYIMYRGLRLGYARISHAELSDSEI
QMAKFRIPDDPTNYRDNQKVVIDHREVSEKIHFNPRFGSYKEGHNYENNHHFHMNTPKYFL

Steve Chappell Mitchell
Associate Scientist
UroGenesys
1701 Colorado Avenue
Santa Monica, CA 90404
Tel (310)820-8029 x281
Fax (310)820-8489
Email smitchell@urogenesys.com
Url www.urogenesys.com